

Appl. No. 10/769,487
Docket No. 5494CRD2
Amdt. dated October 26, 2006
Reply to Office Action mailed on July 27, 2006
Customer No. 27752

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REMARKS

Claim Status

Claims 1-8, 10-11 and 28-31 are pending in the present application. No additional claims fee is believed to be due.

Claims 3-7 have been canceled without prejudice.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, Second Paragraph

The Office Action States Claims 3-7 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3-7 have been canceled in the instant Response. Therefore, Applicants respectfully submit the rejection is moot, and request withdrawal of the 35 USC §112 rejection of Claims 3-7.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148)

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148).

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

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The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action states, "Application of the lotion in a nonuniform pattern ... is deemed to be a matter of engineering design choice, and does not serve to patentably distinguish the claimed subject matter over the prior art." (Office Action, page 4).

Applicants respectfully submit that "deeming" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness.

Specifically, the Office Action has failed to (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that the Office Action has not shown where motivation is found in Duncan to make any one of these changes, much less all three.

Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,118,041

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,118,041.

Claims 3-7 have been canceled.

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The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '041 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '041 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '041 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '041, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things simply because diapers and feminine hygiene articles are "structural and functional equivalents" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '041 in at least three ways: (1) to be a feminine

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hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that the Office Action has not shown where motivation is found in Duncan or '041 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,426,444

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,426,444.

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '444 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '444 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

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The Office Action identified no disclosure in '444 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '444."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '444 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that the Office Action has not shown where motivation is found in Duncan or '444 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,586,652

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,586,652.

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Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '652 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '652 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '652 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '652."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '652 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that the Office

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Action has not shown where motivation is found in Duncan or '652 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,861,571

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,861,571.

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '571 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '571 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '571 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

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Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '571."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '571 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that the Office Action has not shown where motivation is found in Duncan or '571 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,635,191

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,635,191.

Claims 3-7 have been canceled.

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The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '191 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '191 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '191 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '191, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art.

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things simply because diapers and feminine hygiene articles are "structural and functional equivalents" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '191 in at least three ways: (1) to be a feminine

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hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that there is no motivation found in Duncan or '191 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,643,588

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,643,588.

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '588 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '588 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

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The Office Action identified no disclosure in '588 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '588, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things simply because diapers and feminine hygiene articles are "structural and functional equivalents" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '588 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that there is no motivation found in Duncan or '588 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,607,760

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Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,607,760.

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '760 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '760 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '760 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '760, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things simply because diapers and feminine hygiene articles are "structural and functional equivalents" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from

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the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '760 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that there is no motivation found in Duncan or '760 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,609,587

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,609,587.

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '587 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

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The Office Action identified no disclosure in '587 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '587 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '587, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things simply because diapers and feminine hygiene articles are "structural and functional equivalents" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '587 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that there is no motivation found in Duncan or '587 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

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**Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in
view of U.S. Patent No. 5,968,025**

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 5,968,025.

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

The Office Action identified no disclosure in '025 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '025 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '025 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '025, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things simply because diapers and feminine hygiene articles are "structural and functional equivalents" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers

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could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '025 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that there is no motivation found in Duncan or '025 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Rejection Under 35 USC §103(a) Over Duncan, et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,825,393

Claims 1-12 and 28-35 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Duncan et al. (U.S. Patent No. 3,489,148) in view of U.S. Patent No. 6,825,393.

Claims 3-7 have been canceled.

The Office Action does not state where in Duncan is found any disclosure of a feminine hygiene garment, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of a hydrophilic topsheet, as claimed in Claim 1.

The Office Action does not state where in Duncan is found disclosure of lotion applied to the topsheet nonuniformly, as claimed in Claim 1.

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The Office Action identified no disclosure in '393 to prompt the skilled person to modify Duncan to be a feminine hygiene garment rather than a baby diaper.

The Office Action identified no disclosure in '393 to prompt the skilled person to modify Duncan to use a hydrophilic topsheet.

The Office Action identified no disclosure in '393 to prompt the skilled person to modify Duncan to have the lotion applied to the topsheet nonuniformly.

Instead, the Office Action stated, "One of ordinary skill in the art ... would have expected a similar article from the instant claims, given the claims of U.S. '393, since diapers and feminine hygiene garments are considered structural and functional equivalents in the art."

Applicants respectfully submit that "considering" what one would have "expected" based on similarity of two things simply because diapers and feminine hygiene articles are "structural and functional equivalents" is not the standard set forth by the US Supreme Court, the CAFC, or the MPEP for making out a *prima facie* case of obviousness. If this was the standard, then no new feminine hygiene articles or diapers could be patented; all share a certain minimal similarity. The correct standard, as articulated in MPEP §2143, for example, is that the Office Action must at least (1) identify in the prior art all the claim limitations, and (2) provided some motivation from the references themselves to prompt the skilled person to modify the prior art to achieve the claimed invention. See, MPEP §2143.

In the present case, the Office Action must show how the skilled person would be motivated to modify Duncan in view of '393 in at least three ways: (1) to be a feminine hygiene garment rather than a baby diaper, to (2) use a hydrophilic topsheet, and (3) to have the lotion applied to the topsheet nonuniformly. Applicants submit that there is no motivation found in Duncan or '393 to make any one of these changes, much less all three.

For these reasons, the Applicants submit that the Office Action has failed to establish a *prima facie* case of obviousness. Because the Office Action has not yet made out a *prima facie* case of obviousness, the Applicants respectfully request the rejection be withdrawn and Claims 1, 2, 8-12 and 28-35 be allowed.

Appl. No. 10/769,487
Docket No. 5494CRD2
Amdt. dated October 26, 2006
Reply to Office Action mailed on July 27, 2006
Customer No. 27752

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Double Patenting

Claims 1-12 and 28-35 have been rejected under the judicially created doctrine of obviousness-type double patenting over Claims 1-29 of U.S. Patent No. 6,118,041, Claims 1-20 of U.S. Patent No. 6,426,444, Claims 1-24 of U.S. Patent No. 6,586,652, Claims 1-21 of U.S. Patent No. 6,861,571, Claims 1-22 of U.S. Patent No. 5,635,191, Claims 1-24 of U.S. Patent No. 5,643,588, Claims 1-16 of U.S. Patent No. 5,607,760, Claims 1-25 of U.S. Patent No. 5,609,587, Claims 1-25 of U.S. Patent No. 5,968,025, Claims 1-18 of U.S. Patent No. 6,825,393, Claims 1-31 of copending application 10/769,439, copending application 10/262,036, and copending application 11/300,715.

For all the reasons provided above, Applicants submit that the instant claims are, in fact, nonobvious over the references cited for double patenting. For each of the cited references, the Office Action has failed to make out a *prima facie* case of obviousness. However, without commenting on the validity of the double patenting rejection, the Applicants agree to submit any necessary terminal disclaimers upon the indication of allowable subject matter.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §§112 and 103(a). Early and favorable action in the case is respectfully requested.

In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1, 2, 8-12 and 28-35 is respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Signature

Roddy M. Bullock

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Date: Oct 26 2006
Customer No. 27752